

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

O I P E S C
JUL 21 2005
PATENT & TRADEMARK OFFICE

Appln. No: 10,659,082
Applicant: Joel Bartholf and Dennis Ruth
Filed: September 10, 2003
Title: SHIPPING DEVICE AND METHOD FOR ARTICLES CAPABLE OF
RELEASING GAS CONTAINING HAZARDOUS PARTICULATES
TC/A.U.: 3721
Examiner: Louis K. Huynh
Confirmation No.: 2732
Docket No.: 3SI-138US

RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SIR :

This is in response to the Restriction Requirement stated in the Office Letter dated **June 14, 2005**.

The Office Action requires that claims of either Group I -- claims 1-17 and 32 (drawn to an enclosure, classified in class 229, subclass 80.5); or Group II -- claims 18-31 and 33 (drawn to a method of sealing an enclosure, classified in class 53, subclass 460) be elected for prosecution. Applicants respectfully elect to prosecute Group II. This election is made with traverse.

Reasons for Traverse

The Office Action states that the inventions are distinct because "the process for using the product as claimed can be practiced with another materially different product such as a standard envelope." The applicants respectfully disagree.

Claim 1 of this invention reads :

1. An enclosure for shipping an article capable of releasing a combination of gas and particulates, **the enclosure comprising a material of construction adapted to allow escape of the gas from the enclosure while retaining the particulates within the enclosure, sized to contain the article, and having no breaches capable of allowing escape of the particulates except for an opening at the top end**, the opening adapted to be sealed in a closed

configuration adapted to prevent escape of the particulates.

Claim 18 recites:

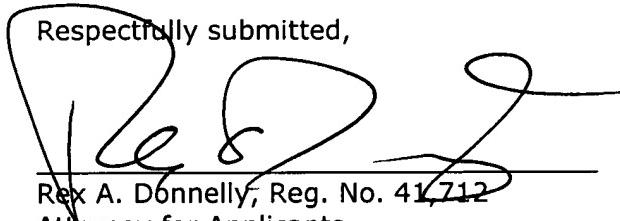
18. A method for shipping a device capable of releasing a combination of gas and particulates, the method comprising the steps of:
 - (a) **providing an enclosure comprising a material of construction adapted to allow escape of the gas from the enclosure while retaining the particulates within the enclosure, sized to contain the article, and having no breaches capable of allowing escape of the particulates except for an opening at the top end;**
 - (b) inserting the article in the enclosure; and
 - (c) **sealing the top end in a closed configuration adapted to prevent escape of the particulates.**

The language (highlighted in bold, above) in claim 1 and claim 18 is identical with respect to the claimed features of the enclosure. Accordingly, the method claim specifically requires that the method be practiced using a product that is essentially identical to the enclosure recited in claim 1. Accordingly, there is no support for the statement by the office that the method could be practiced using another materially different product.

The mere fact that there are separate apparatus and method claims in the same application is not grounds for a restriction. See *Applied Materials, Inc. v. Advanced Semiconductor Materials Am., Inc.*, 40 USPQ2d 1481, 1492 (Fed. Cir. 1996), (Archer concurrence, citing *Symbol Technologies, Inc. v. Opticon, Inc.*, 935 F.2d 1569, 1580, 19 USPQ2d 1241, 1249 (Fed. Cir. 1991)). The Office must show that either the apparatus or method must be capable of being practiced without the other. MPEP § 806.05(h). This has not been shown. The office action does not even allege that the apparatus can be practiced without the method, and the allegation that the method can be practiced without the apparatus, is not supported by a review of the actual claim language.

Furthermore, the applicant respectfully submits that there is no burden on the office to examine both groups of claims at the same time, as the limitations in one group are materially the same as in the other group. For all of the above reasons, the applicant respectfully requests reconsideration and withdrawal of the restriction requirement.

Respectfully submitted,


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RAD:rc

Dated: July 18, 2005

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The Commissioner for Patents is hereby authorized to charge payment to Deposit Account No. 18-0350 of any fees associated with this communication.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on:

July 18, 2005



Ruth Curran